



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,057	10/12/2004	Hubert Baumgart	PAT-00293	2264
26922	7590	12/14/2007		
BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 12/14/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LORI.HASS@BASF.COM
MARJORIE.ELLIS@BASF.COM
ANNE.SABOURIN@BASF.COM

Office Action Summary	Application No. 10/511,057	Applicant(s) BAÜMGART ET AL.	
	Examiner William K. Cheung	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on October 17, 2007 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/511057 is acceptable and a RCE has been established. An action on the RCE follows.
2. In view of the amendment filed September 17, 2007 for the specification, the rejection of claims 12-14 are rejected under 35 U.S.C. 112, second paragraph is withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Voris et al. (US 7,056,522) for the reasons adequately set forth from paragraph 5 of the office action of July 17, 2007.

Voris et al. (col. 9, line 5 to col. 11, line 52) disclose a mixture composition comprising at least one oligomer and/or polymer that contains at least one allophanate group (col. 10, line 29-47), and an urea or an urea derivative prepared by reacting at least one amine and/or water with at least one polyisocyanate (col. 10, line 48-61).

Regarding the claimed "heat-curable" feature, Voris et al. (col. 9, line 5 to col. 11, line 52) clearly teach a composition that is curable (or crosslinkable). Although Voris et al. do not explicitly indicate that the disclosed curable composition is curable by heat, applicants must recognize that it is well known that the crosslinking reaction of Voris et al. can be accelerated with "heat". Therefore, the examiner has a reasonable basis that Voris et al have met the claimed "heat curable" feature. Regarding the claimed "thixotropic agent" feature, in view of the substantially identical composition of Voris et al. and the composition as claimed, the examiner has a reasonable basis that the claimed "thioxotropic agent" is inherently possessed in Voris et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Regarding claimed "silica" of claim 2 and 10, Voris et al. (col. 6, line 34) clearly teach the inclusion of silica, which generically can either be hydrophobic or hydrophilic.

Regarding the claimed "wetting agent" of claim 3, applicants' claim 11 clearly disclose that polyurethanes are good wetting agent which is also taught in Voris et al. through out the entire disclosure.

Regarding the claimed "addition (co)polymer" and "a polycondensation resin" of claims 4, 5, Voris et al. (col. 6, line 23-67; col. 12, line 6-42) clearly teach such a composition comprising polyethylene, polypropylene, PET, or polyurethane (col. 6, line 40-43). Further, Voris et al. (col. 6, line 65-67) clearly teach the inclusion of nylon, ethylene-vinyl alcohol (hydrolyzed polyvinylacetate), epoxy resins, and unsaturated polyesters. Voris et al. (col. 12, line 14) clearly teach the inclusion of styrene-butadiene rubber (which can be a block copolymer), polyacrylates, polymethacrylates, and polyurethanes (col. 12, line 12-14).

Regarding claims 6, 7, Voris et al. (col. 10, line 43-44) clearly disclose the use of amine based catalyst, which generically includes the broad number of families of amines being claimed.

Regarding claim 9, Voris et al. (col. 9, line 23-34) clearly disclose the use of HDI and other diisocyanates.

Regarding the claimed coating application methods of claims 17-19, Voris et al. (abstract) clearly teach the claimed coating applications. Regarding the claimed "clearcoat" feature of claim 18, in view of the substantially identical composition of Voris et al. and the composition as claimed, the examiner has a reasonable basis that Voris et al. inherently possess the claimed "clearcoat" feature. Voris et al. (col. 1, line 18-49) clearly disclose the various type of substrates and applications that the disclosed coating composition can be used.

Applicant's arguments filed September 17, 2007 have been fully considered but they are not persuasive.

Applicants' comment that the reference of Voris et al. published on July 4, 2002 is a CIP of US 6,322,803 filed on July 3, 1999. Then applicants argue that since the critical date of Voris et al. can not be carried back to the filing date of the Parent application because the claimed invention in Voris et al. is not supported by the Parent application. However, applicants fail to recognize that filing date of Voris et al. (US 7,056,522) is November 27, 2001. Since applicants' priority date is April 24, 2002, it is proper for the examiner to use Voris et al. as a 102(e) reference.

Regarding applicants' argument that Voris et al. teach allophanate as one of six possible types of crosslinking, and Voris et al. do not teach a mixture containing allophanate groups comprising both (A) at least one oligomer and/or polymer containing at least one allophanate group or contains one carbamate group or contains one carbamate group and at least one allophanate group, and (B) at least one thixotropic agent comprising a urea or a urea derivative prepared by reacting at least one amine and/or water with at least one polyisocyanate, the examiner disagrees because Voris et al. (col. 10, line 3-4) clearly teach a system comprising six types of crosslinks, not six possible type of crosslinks.

Regarding applicants' comment that the examiner fails to consider Voris et al. as a whole to interpret the Voris et al. only teach that there are six possible type of crosslinks, however, contrary to applicants' beliefs, because the examiner considers the reference as a whole to believe that Voris et al. teach a composition comprises all six

type of crosslinks disclosed. Applicants must recognize that the six types of crosslinks are formed automatically when the polymerization reaction takes place. The amount of each of the six species of crosslinks result from the polymerization process depends on the reaction conditions.

Regarding the claimed "mixture" feature, applicants must recognize that a polyurethane resin is inherently a mixture of polyols, polyisocyanate, etc.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

Application/Control Number:
10/511,057
Art Unit: 1796

Page 8

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William K. Cheung, Ph.D.

Primary Examiner

December 3, 2007

WILLIAM K. CHEUNG
PRIMARY EXAMINER